

***United States Court of Appeals
for the Second Circuit***



**PETITION FOR
REHEARING**

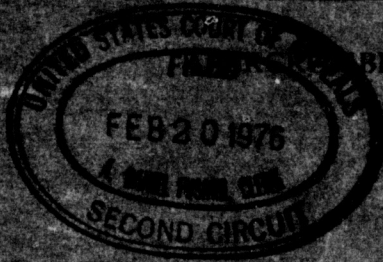
74-2540

To be argued by
RICHARD H. WELS

In The

United States Court of Appeals

For The Second Circuit



PERKINS & FITCH COMPANY,

Plaintiff-Appellant

vs.

HUNTING WORLD, INCORPORATED,

Defendant-Appellee.

On Appeal from the United States District Court for the
Southern District of New York

Civil Action No. 70 Civ. 377, Ryan, J.

**DEFENDANT-APPELLEE'S RESPONSE TO
PLAINTIFF-APPELLANT'S PETITION FOR
REHEARING**

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ORIGINAL

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No. 74-2540

ABERCROMBIE & FITCH COMPANY,

Plaintiff-Appellant,

vs.

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Defendant-Appellee.

*On Appeal from the United States District Court for the
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**DEFENDANT-APPELLEE'S RESPONSE TO PLAINTIFF-
APPELLANT'S PETITION FOR REHEARING**

This response to the petition for rehearing filed by the appellant is submitted pursuant to the order of this Court dated February 5, 1976, directing that a response be filed.

Registration No. 703,279 must be cancelled as to shirts.

Appellant errs in stating in its petition that "the issue as to shirts was basically not before the lower courts or this Court."

It was appellant who created the issue with respect to safari shirts. Thus Mr. Geis, appellant's only witness, testified (A86):

"I would state that the design of the shirts or the jackets in most instances represent a combination of design by our merchants and the manufacturer.

Obviously, certain standard manufacturing techniques are required, but we want to make sure that this merchandise is fit for a particular use, so that when we have a Safari shirt, one of the requirements is that it have a large pocket because people are using it for an outdoor use, and it is that type of detail that we are very insistent that goes into the shirt."

Appellee Hunting World also makes and sells safari shirts. Thus, (A282-283), Robert M. Lee testified as follows:

"Q. I show you Defendant's Exhibit AAA for identification, Mr. Lee, and I ask you if you can tell me, if you can identify that for me. A. This is one of our safari shirts. It is not

in the catalog. It is made to our design in France, out of very fine cotton or gabardine. It is not, incidentally, a color that we recommend for the bush.

Q. Do you advertise this as a safari shirt or a shirt for safari? A. We have never advertised this shirt. It is a new shirt, but we, in the store of course, we call it a safari shirt.

Q. Is it similar to shirts that are worn on safari? A. Yes, it is.

Q. Is this a man's shirt or a woman's shirt? A. This one is a man's. We make it for women too.

Q. Have you worn shirts like that on safari? A. Yes, I have.

Q. Seen them worn by others? A. Yes."

On cross-examination of Mr. Lee, appellant drew from him the statement (A328) that among the clothing which appellee sold and advertised was included "a bush shirt."

The record is clear that the upper garment of the safari suit is referred to interchangeably as a safari bush jacket and as a safari shirt (A291-292).

In the District Court Judge Ryan cancelled appellant's trademark registrations because

"After hearing the evidence, I go further and do now find that the mark is invalid because it is merely descriptive and does not serve to distinguish plaintiff's goods as listed in the registration from anybody else's. . . . Besides widespread use by plaintiff on other products and in other senses to describe the source or type of its goods and services, and its inability to control its use by others, have caused it to lose any identification it might have had originally with plaintiff's goods (although there was no proof of this) and a total loss of rights in it (15 U.S.C. 1064(c)(e), 1127; *Dupont Cellophane Co. v. Waxed Products Co.*, 85 F.2d 75 (C.A. 2, 1936).

Under the statute, a descriptive name may be protected only if it has through use become identified with plaintiff as its producer, rather than with its products. 15 U.S.C. 1052(e)(f)."

Here, with respect to shirts, appellant has used the term "safari" in reference to shirts only in a descriptive sense, and not in a trademark sense. Appellant refers the Court to its use reproduced on page 8 of its main brief. Such uses are purely descriptive, with no trademark registration noticed: e.g., "Safari Cloth Shirt. The perfect hunting/camping shirt," and "SAFARI SHIRT (left) Rugged but lightweight, mantailored of A & F's own Safari Cloth."

The record is replete with examples of appellant's use of "safari shirt" in a descriptive, and not in a trademark sense. At page 46 of DX-MM, one of its catalogs, it refers to "Safari sport

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shirt features two flap pockets." Appellant's Blazed Trail, 1973 catalog (DX-SS) refers on page 20 to its "long-sleeved Safari cloth shirt." Its references to safari shirts in other catalogs have always been in the descriptive sense, and never with any indication of trademark registration. Other advertisers, as, for example, Lord & Taylor, have advertised "Safari shirt-jacket," in the same way that appellant does. And, in the New York Times on June 3, 1975, appellant, again using "Safari" in a descriptive sense, advertised, under the caption "SAFARI IN BLUE", its "Shirt jacket."

There is no merit to appellant's request that "shirts" be deleted from footnote 14 of the Court's decision on page 1580.

II

The Court's holding of fair use as to "Hippo Safari" and "Camel Safari" was correct, and reconsideration should not be granted.

In his decision on the original motion for summary judgment, Judge Lasker had held that no summary judgment could be granted on the use of "safari" in respect of shoes "Since a genuine issue of fact exists as to whether plaintiff has created a secondary meaning in the word 'Safari' as applied to its shoes" (A38-39).

At the trial Judge Ryan found that appellant did not establish secondary meaning for its marks (A64), and this Court, in footnote 4 to its decision, noted that appellant has not disputed such finding.

Judge Ryan found that appellee's use of "safari" in connection with hats and shoes was purely descriptive. Appellant said in its main brief on this appeal virtually everything that it now says in "II" of its petition with respect to "Hippo Safari" and "Camel Safari," and it has made no showing that Judge Ryan's decision was clearly erroneous.

But, in "II" of its petition, appellant erroneously states that "The evidence on this point is entirely documentary." At pages A280 and A281 Mr. Lee was questioned on direct examination both by his own counsel and by Judge Ryan with respect to the "Camel Safari" and "Hippo Safari" shoes. Appellant chose not to cross-examine as to this, except at page A320, to ask "Is that the one that you call the hippo safari?"

New York Times - June 3, 1975 -

A&F

Safari in blue

Safari, the look that A&F made famous, takes on a new perspective in this season's favorite shade—dusty blue! Tailored with all the styling details that you've come to expect from A&F in a cool blend of polyester and cotton. Third floor

Blazer jacket. 6-18. 58-5008. \$42.

Modified bush jacket with set-in back belt. 6-18. 58-308. \$36.

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The Bold and the Beautiful... to make you feel that way! In bold and colors, bright for spring. Safari shirt-jacket in our Chamden blend, tailored with a difference. Contour-waist pants in seersucker plaid. Both in 50% cotton. Sizes 6-18. The shirt-jacket about \$25; the pants about

Activat puts the knit polo shirt under all. 100% nylon. Sizes 34-40; about \$16.

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Mr. Lee testified that he made up his regular "safari shoe in hippopotamus leather" and that "it was sold as a Hippo safari" (A280). Appellee's advertisement (PDX-16) referred to "HIPPO SAFARI, the same smart pattern as the Kenya Club, but in top grain genuine Hippopotamus Suede."

In appellant's petition under Item "II," in its discussion of "Hippo Safari" and "Camel Safari," the statement is made in a footnote that "Indeed, Mr. Lee testified in pretrial examination that some of the shoes were made by Johnson & Murphy with leather soles intended for "business wear." This is, of course, misleading. Reference to such pages of the deposition (A398-399) makes it very clear that Johnson & Murphy did not make either "Hippo Safari" or "Camel Safari" for appellee. The record is very clear that Johnson & Murphy made up shoes of elephant leather which were sold by appellee as "The Elephant Chukka."

Nor does appellant accurately state the description used by appellee of its "CAMEL SAFARI CHUKKAS." What appellee said (PDX-12) was

"Genuine natural Camel Leather. Unique, durable, attractive. Hides are obtained from nomadic East African tribesmen whose camel herds represent their wealth. Tanned in England to our specifications, the finished leather is hand crafted by skilled European bootmakers to produce these handsome, rugged chukkas."

A comparison of the Camel Safari Chukka (PDX-12) with the standard Safari Boot made by appellee's African supplier, BATA (DX-FFF), shows them to be identical, square toes and

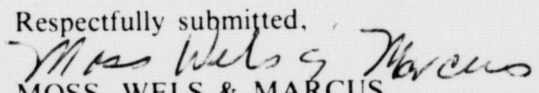
all, except for the different leathers, and the use of brass buckles instead of laces.

Certainly, if appellee can advertise shoes or boots of the kind worn on safaris as a safari shoe or safari boot, it may also advertise a similar shoe or boot, made of hippo leather, as a hippo safari shoe, and a similar shoe or boot, made of camel leather, as a camel safari shoe or camel safari boot.

There has been no claim, nor could there be, that appellant ever merchandised, manufactured or sold shoes made of hippopotamus leather or camel leather.

The petition for rehearing should in all respects be denied.

Respectfully submitted,


MOSS, WELS & MARCUS
Attorneys for Defendant-Appellee

Richard H. Wels
Of Counsel

ABERCROMBIE & FITCH CO.,
Plaintiff- Appellant,

- against -

HUNTING WORLD INC.,
Defendant- Appellee.

Index No.

Affidavit of Personal Service

STATE OF NEW YORK, COUNTY OF NEW YORK

ss.:

I, Victor Ortega, *being duly sworn,*
depose and say that deponent is not a party to the action, is over 18 years of age and resides at
1027 Avenue St. John, Bronx, New York
That on the 20th day of February 19 76 at 60 East 42nd Street, New York, New York
deponent served the annexed Petition upon

HOPGOOD CALIMAFDE KALI BLAUSTEIN & LIEBERMAN
the Attorneys in this action by delivering a true copy thereof to said individual
personally. Deponent knew the person so served to be the person mentioned and described in said
papers as the herein,

Sworn to before me, this 20th
day of February 19 76

Robert T. Brin

Victor Ortega

VICTOR ORTEGA

ROBERT T. BRIN
NOTARY PUBLIC, State of New York
No. 31 0418950
Qualified in New York County
Commission Expires March 30, 1977.